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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Newman.

Serial No.: 09/839,444

Confirmation No.: 4848

Filed: April 23, 2001

For: METHOD OF MANAGING A WELL FILE  
RECORD AT A WELL SITE

Group Art Unit: 2862

Examiner: T. Le

Atty. Dkt. No.: 13526.0023.NPUS00

**RESPONSE TO OFFICE ACTION MAILED AUGUST 29, 2003**

Commissioner for Patents  
Washington, D.C. 20231

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| CERTIFICATE OF EXPRESS MAIL  |            |
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**INTRODUCTORY COMMENTS:**

The following is submitted in response to the Office Action dated June 2, 2003:

RECEIVED  
DEC - 3 2003  
TC 2800 MAIL ROOM



Serial No.: 09/839,444  
Confirmation No.: 4848  
Applicant: Newman  
Atty. Ref.: 13526.0023.NPUS00

**AMENDMENTS TO THE CLAIMS:**

No amendments are being made to the claims at this time.

**IN RESPONSE TO THE OFFICE ACTION:**

**CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

The Examiner has rejected a number of claims as follows:

*Claims 1, 6, 10-13, and 15 are rejected under 35 U.S.C. § 102(e) as being anticipated by Harvey et al.*

*Referring to claim 1, Harvey et al. disclose a method of managing a well file record of a plurality of components of a well at a well site, comprising: storing a well file at a first computer, wherein the well file includes information about the plurality of components at the well (col. 13, lines 29-45); transporting a second computer to the well site (figure 1); providing a wireless communication link between the first computer and the second computer (col. 5, lines 9-13); communicating the well file from the first computer to the second computer through the wireless communication link (col. 30, lines 8-11); changing one of the plurality of components of the well at the well site; imputing into the second computer a well file change that documents the step of changing one of the plurality of components of the well (col. 30, lines 20-23; figure 16); and making the well file change of the second computer accessible to the first computer through the wireless communication link (col. 30, lines 8-11).*

Claim 1 of the instant application calls for the well file to be transferred from the first computer to the second computer. In the instant application, the first computer is a computer that is not located at the well site, while the second computer is located at the well site. Thus, according to claim 1, the first computer must transfer the well file to the second computer at the well site. In rejecting claim 1, the Examiner cites column 30, lines 9-11 from Harvey et al. as showing this limitation of the claim. However, this section of Harvey et al. reads as follows: "...transmitting oilfield data over a first communications network from a data acquisition site computer to the central data hub computer...." As explained by Harvey et al. at column 8, lines 27-47, the acquisition site is the well site, while the central data hub is centrally located. Therefore, using Applicant's claim language, the data acquisition site computer is the second computer, and the central data hub computer is the first computer. The section of Harvey et al. cited by the Examiner, column 30, lines 9-11, clearly contemplates a transfer from the *second* computer to the *first* computer. Claim 1 clearly calls for a transfer of the well file from the *first* computer to the *second* computer. Therefore, because the cited passage contemplates a transfer

that is exactly opposite that that is claimed, the Examiner's rejection is not properly supported and should be withdrawn.

Because each of the remaining rejected claims (6, 10-13, and 15) all depend from claim 1, the rejection of these claims should be withdrawn as well, given the patentability of claim 1.

#### CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Examiner has rejected a number of claims as follows:

*Claims 2-5, 7-9, 14, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harvey et al. in view of Newman.*

As shown above Harvey et al. does not anticipate independent claim 1, and therefore Applicant respectfully asserts that the rejection of claims 2-5, 7-9 and 14 under § 103 is therefore moot. However, the entire rejection of Claims 2-5, 7-9, 14, and 16-19 under § 103 is improper because it is based on prior art that is unavailable to the Examiner for use in a § 103 rejection.

Applicant would like to direct the Examiner to its response to the June 2, 2003, Office Action, in which Applicant provided the Examiner numerous grounds as to why Newman '189 cannot be used *at all* by the Examiner to reject the claims of the instant application, either under § 102 or § 103. The text of that argument has been reproduced below:

On February 18, 2003, the currently pending claims were rejected under both 35 U.S.C. § 102 and 35 U.S.C. § 103 as allegedly being anticipated by or obvious in view of U.S. Patent 6,377,189, issued to Frederic M. Newman, the same Frederic M. Newman who is the inventor of material disclosed and claimed in the instant application.

On March 6, 2003, Applicant's representative discussed the instant application with the Examiner. During that discussion, Applicant's representative pointed out to the Examiner that the cited reference, U.S. Patent No. 6,377,189 did not qualify as a prior art reference to this application. In particular, the '189 patent's issue date was April 23, 2002. Because the instant application was filed April 23, 2001, the '189 patent did not qualify as prior art under either § 102(a) or

§ 102(b). Although the '189 patent was filed on March 31, 1999, before the instant application's filing date, the '189 reference did not qualify as § 102(e) prior art because the '189 reference's Applicant is the same Applicant in the instant application, and therefore did not meet the "by another" requirement of § 102(e).

The Examiner agreed with the Applicant's representative's statements, and agreed to withdraw the final rejection issue a new, non-final rejection. Applicant's representative then submitted a "Request to Withdraw Final Office Action" outlining the content of the conversation between the Examiner and the Applicant's representative.

Applicant's request was granted by the Examiner, and a new, non final Office Action was mailed on June 2, 2003. All of the pending claims were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over "Newman"—no patent number was listed. Applicant's representative spoke with the Examiner on July 7, 2003, so as to ascertain what Newman patent was the basis of the rejection. The Examiner informed the Applicant's representative that, again, it was U.S. Patent No. 6,377,189. When Applicant's representative told the Examiner that this reference was not available to him to reject the claims, the Examiner stated that this was not a § 102 rejection, but instead was a § 103 rejection and the '189 patent was therefore available to reject the claims.

The MPEP clearly states that subject matter that is prior art under 35 U.S.C. § 102 can be used to support a rejection under section § 103. MPEP § 2141.01(I). The entirety of MPEP § 2141.01(I) is reproduced below for the Examiner's assistance:

**I. PRIOR ART AVAILABLE UNDER 35 U.S.C. § 102 IS AVAILABLE UNDER 35 U.S.C. § 103**

"Before answering Graham's 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), cert. denied, 481

U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. § 102 can be used to support a rejection under section § 103. Ex parte Andresen, 212 U.S.P.Q. 100, § 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section § 103 as including all of the various bars to a patent as set forth in section § 102.").

A 35 U.S.C. § 103 rejection is based on 35 U.S.C. § 102(a), § 102(b), § 102(e), etc. depending on the type of prior art reference used and its publication or issue date. For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. § 102(b). Analogously, an obviousness rejection based on a publication which would be applied under § 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131.

For an overview of what constitutes prior art under 35 U.S.C. § 102, see MPEP § 901 - § 901.06(d) and § 2121 - § 2129.

MPEP § 2141.01(I).

As is clear from this section of the MPEP, art that would qualify under § 102 is available to reject claims under § 103. The second paragraph is particularly applicable to the instant situation. First sentence of MPEP § 2141.01(I). : "A 35 U.S.C. § 103 rejection is based on 35 U.S.C. § 102(a), § 102(b), § 102(e), etc. depending on the type of prior art reference used and its publication or issue date." In this case, the 35 U.S.C. § 103 rejection is based on § 102(e). As explained above, the only thing U.S. Patent No. 6,377,189 could be is a § 102(e) reference. The issue date of the '189 patent is April 23, 2002, so because the instant application was filed April 23, 2001, the '189 patent does not qualify as prior art under either § 102(a) or § 102(b) (i.e. was not published "before" the invention of the instant application). The '189 patent was filed on March 31, 1999, which was before the instant application's filing date, making § 102(e) the only option to qualify the '189 patent as a prior art reference to the instant application.

The third sentence of MPEP § 2141.01(I) reads as follows: “Analogously, an obviousness rejection based on a publication which would be applied under § 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131.” What this is saying is that if an obviousness rejection is based on a § 102(a) publication, it can be overcome by swearing behind the § 102(a) reference. Therefore, like with an anticipation rejection, if an Applicant can remove the § 102(a) reference by swearing behind it, it is not available for use in a § 103 rejection.

The same can therefore be said for art that falls under § 102(e). An obviousness rejection based on a publication which would be applied under § 102(e) if it anticipated the claims can be overcome by showing that the reference is not prior art under § 102(e). As was shown previously to the Examiner, the ‘189 reference does not qualify as § 102(e) prior art because the ‘189 reference’s Applicant, Frederic M. Newman, is the same Frederic M. Newman who is the applicant in the instant application. Therefore, the ‘189 patent is not “by another” as required by § 102(e), and is not appropriate § 102(e) prior art. Because it is not proper § 102(e) prior art, it cannot be used to make a rejection under § 103.

This is supported the P.J. Frederico’s commentary accompanying the Patent Act of 1952 which is instructive on the issue of what type of prior art is available for use under § 103:

In form this section [35 U.S.C. § 103] is a limitation on section § 102 and it should more logically have been made part of section § 102, but it was made a separate section to prevent § 102 from becoming too long and involved and because of its importance. The antecedent of the words 'the prior art,' which here appear in a statute for the first time, lies in the phrase 'disclosed or described as set forth in section § 102' and *hence these words refer to material specified in section § 102 as the basis for comparison.*

The general part of the Committee Report states with reference to section § 103:

Section § 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writing. Section § 103 states this requirement in the title. *It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section § 102.* If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

P.J. Frederico, *Commentary on the New Patent Act*, 35 U.S.C.A. 1, 20 (1954), reprinted in 75 J. Pat. Off. Soc'y 161 (1993). Clearly, the impetus of this commentary is that § 102 art can be used to support § 103 rejections. A corollary, of course, is that if a printed reference is NOT § 102 art, it cannot be used to support a § 103 rejection. As is clearly stated above, for the purposes of this application, the '189 reference is NOT proper § 102(e) art, and therefore cannot be the basis for either a § 102 rejection or a § 103 rejection.

Clearly, a reference must qualify as prior art under § 102 before it can be used to make an obviousness rejection. The '189 patent is not § 102(e) prior art in this case because the inventive entity for both the '189 patent and the instant application, Frederic M. Newman, are exactly the same. Thus, the Examiner has not made a *prima facie* showing of obviousness because the purported rejection is based on a reference that the Examiner cannot use to make rejections to the currently pending claims. Therefore, the Examiner's § 103 obviousness rejections to all the claims should be withdrawn, and the claims allowed.

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As is clearly shown above, the Newman '189 reference is not § 102(a) or (b) prior art. § 102(e) clearly states that to qualify as prior art under § 102(e) the art must be "by another." As



has now been repeatedly shown to the Examiner, the '189 reference does not qualify as § 102(e) prior art because the '189 reference's Applicant, Frederic M. Newman, is the same Frederic M. Newman who is the applicant in the instant application. Therefore, the '189 patent is not "by another" as required by § 102(e), and is not appropriate § 102(e) prior art.

**Because the Newman '189 reference is not proper prior art to the instant application under any section of § 102, it cannot be used to make a rejection under § 103.**

Therefore, the Examiner has not made a *prima facie* showing of obviousness because the purported rejection is based on a reference that the Examiner cannot use to make rejections to the currently pending claims. Therefore, the Examiner's § 103 obviousness rejections to all the claims should be withdrawn, and the claims allowed.

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While no fees are believed to be due at this time, the undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 01-2508, referencing Order No. 13526.0023.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.



Serial No.: 09/839,444  
Confirmation No.: 4848  
Applicant: Newman  
Atty. Ref.: 13526.0023.NPUS00

Respectfully submitted,

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Date: 11/24/03